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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|---------------------------|--|
| Proceeding | 91211397 |
| Party | Defendant Motorola Trademark Holdings, LLC |
| Correspondence Address | WILLIAM R. ANDERSON MOTOROLA TRADEMARK HOLDINGS, LLC 600 N US HIGHWAY 45 LIBERTYVILLE, IL 60048-5343 mxg674@motorola.com |
| Submission | Motion to Suspend for Civil Action |
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| Signature | /s/ Thomas M. Williams |
| Date | 08/02/2013 |
| Attachments | Applicants Motion to Suspend Proceeding.pdf(1166414 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

| | | |
|--|---|---------------------------|
| Application Serial No. 85/792,653 |) | |
| Filed: December 3, 2012 |) | |
| Published: March 5, 2013, in the <i>Official Gazette</i> |) | |
| For: MAXXCHARGE |) | |
| |) | |
| Mag Instrument, Inc. |) | |
| |) | Opposition No. 91/211,397 |
| Opposer, |) | |
| |) | |
| vs. |) | |
| |) | |
| Motorola Trademark Holdings, LLC |) | |
| |) | |
| Applicant. |) | |
| |) | |

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

**APPLICANT’S MOTION TO SUSPEND PROCEEDING
PURSUANT TO CIVIL ACTION**

Pursuant to 37 C.F.R. § 2.117(a) and T.B.M.P. § 510.02(a), Applicant Motorola Trademark Holdings, LLC (“Applicant”) hereby notifies the Board that Applicant is engaged in a civil action that may have a bearing on the case. Applicant requests the Board to suspend this proceeding pending resolution of the civil action. In support, Applicant states as follows:

1. On March 11, 2013, third parties Waves Audio Ltd. and Waves Inc. (collectively, “Waves”) filed a trademark infringement Complaint in the United States District Court for the Northern District of California against Applicant and its related entity Motorola Mobility LLC. *See Waves Audio Ltd. and Waves Inc. v. Motorola Mobility LLC and Motorola Trademark*

Holdings, LLC, Case No. 13-CV-1091 (EMC)¹ (N.D. Cal.) (the “Civil Action”). A copy of the Complaint is attached as Exhibit 1.

2. The Complaint in the Civil Action alleges that Applicant’s use of “colorable imitations” of Waves’ asserted trademarks MAXX, MAXXAUDIO, MAXXBASS, and MAXXVOLUME is likely to cause confusion. (Ex. 1, Complaint at ¶ 50.) The Complaint expressly identifies Applicant’s co-pending MAXX trademark application covering “mobile phones, smartphones, and accessories therefor, namely, power adapters” (Ser. No. 85/792,643). (Ex. 1, Complaint at ¶ 43.) The Complaint alleges trademark infringement and unfair competition under the Lanham Act, as well as related state law claims. Among other relief, Waves seeks an injunction against Applicant’s use of the MAXX trademark. (Ex. 1, Complaint at pp. 13-14.)

3. Upon Applicant’s motion, and based upon the Civil Action, the Board suspended a co-pending opposition proceeding filed by Waves against Applicant’s application to register the MAXX trademark for use in connection with “mobile phones, smartphones, and accessories therefor, namely, power adapters” (Ser. No. 85/792,643). *See Waves Audio Ltd. v. Motorola Trademark Holdings, LLC*, T.T.A.B. Case No. 91/209,701 at Dkt. #8 (Order suspending proceedings dated May 14, 2013).

4. The applied-for trademark at issue in this proceeding (Case No. 91/211,397) is MAXXCHARGE covering “mobile phones, smartphones and accessories therefor, namely, power adapters” (Ser. No. 85/792,653). These goods are identical to the goods at issue in Waves’ Civil Action, in which Waves seeks an injunction against Applicant’s use of the MAXX

¹ The Civil Action was subsequently reassigned to a new judge. Consequently, the new case number is 13-CV-1091 (WHO).

trademark and “colorable imitations” of Waves’ asserted trademarks.² As a result, the Civil Action may have a bearing on the above-captioned proceeding.

In light of the foregoing, suspension is proper. *See* 37 C.F.R. § 2.117(a), T.B.M.P. § 510.02(a). As set forth in the Board Manual, “[P]ursuant to 37 C.F.R. § 2.117(a), the Board may also, in its discretion, suspend a proceeding pending the final determination of another Board proceeding ... or even another proceeding in which only one of the parties is involved.”

T.B.M.P. § 510.02(a). “Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board.” *Id.* The other proceeding need not be dispositive, but only needs to have a bearing on the issues. *Id.* (citing *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 U.S.P.Q.2d 1550, 1552 (T.T.A.B. 2011)).

Although the plaintiffs in the Civil Action, Waves Audio Ltd. and Waves Inc., are not parties to this opposition, suspension is still proper. *See Argo & Co., Inc. v. Carpetsheen Mfg., Inc.*, 187 U.S.P.Q. 366 (T.T.A.B. 1975). Applicant is a defendant in each of the pending proceedings described above, including the Civil Action. The district court’s ruling with respect to the “MAXX” trademark may be binding on the Board. *See New Orleans Louisiana Saints*, 99 U.S.P.Q.2d at 1552. As a result, the Civil Action may have a bearing on these proceedings. If the Civil Action plaintiffs’ claims are ultimately successful—which Applicant will vigorously contest—Applicant may be enjoined from using a “MAXX”-formative trademark in connection with the applied-for goods. If that occurs, Applicant would be unable to perfect use of the applied-for MAXXCHARGE mark and the application at issue in this proceeding would ultimately go abandoned.

² These goods are also identical to the goods at issue in Waves’ now-suspended MAXX trademark opposition proceeding (Case No. 91/209,701).

If the district court issues an injunction in the Civil Action, there may be no need to proceed with this opposition. Conversely, if the district court dismisses Waves' claims, this opposition can proceed. Consequently, Applicant respectfully requests the Board to suspend proceedings pending the outcome of the Civil Action. *See General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 U.S.P.Q.2d 1933, 1937 (T.T.A.B. 1992) (granting motion to suspend). In the event the Board denies Applicant's Motion to Suspend, Applicant respectfully requests the Board to reset Applicant's deadline to file an Answer or otherwise plead.

Dated: August 2, 2013

BY:
ULMER & BERNE, LLP

BY: /s/ Thomas M. Williams
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CERTIFICATE OF SERVICE

On August 2, 2013, I served the foregoing **APPLICANT’S MOTION TO SUSPEND PROCEEDING PURSUANT TO CIVIL ACTION** on the parties in said action by depositing a true copy thereof with the United States Postal Service as first class mail, postage prepaid, at Chicago, Illinois, enclosed in a sealed envelope addressed to counsel of record for Opposer as follows:

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Dated: August 2, 2013

By: /s/ Thomas M. Williams
Thomas M. Williams

EXHIBIT 1

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Counsel for Plaintiffs
 WAVES AUDIO LTD., AND
 WAVES INC.

UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 SAN JOSE DIVISION

WAVES AUDIO LTD. AND WAVES INC.,)

Plaintiffs)

vs.)

MOTOROLA MOBILITY LLC AND)
 MOTOROLA TRADEMARK HOLDINGS,)
 LLC,)

Defendants)

PLAINTIFFS' ORIGINAL COMPLAINT

DEMAND FOR JURY TRIAL

PLAINTIFFS' ORIGINAL COMPLAINT

Filed

MAR 11 2013

RICHARD W. WIEKING
 CLERK, U.S. DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 SAN JOSE

EMC

Cas. No: V13-1091

1 This is a lawsuit by Waves Audio Ltd. and Waves Inc. (collectively "Waves") for relief
2 from trademark infringement, dilution and other unlawful acts of Motorola Mobility LLC and
3 Motorola Trademark Holdings, LLC (collectively "Motorola"). Motorola unlawfully, willfully
4 and without authorization has used and continues to use Waves' registered trademark
5 "MAXX" on Motorola's mobile phones. Motorola's conduct has tarnished the mark MAXX
6 and its related trademark family and harmed the reputation of Waves.

7 PARTIES

8 1. Waves Inc. is a corporation organized under the laws of Delaware. Its principal
9 place of business is 2800 Merchants Drive, Knoxville, TN 37912.

10 2. Waves Audio Ltd. is a company organized under the laws of Israel. Its
11 principal place of business is Azrieli Center 3, The Triangle Tower, 32nd Floor, Tel-Aviv
12 67023 Israel.

13 3. Waves Inc. is a wholly owned subsidiary of Waves Audio Ltd.

14 4. Upon information and belief, Motorola Mobility LLC is a limited liability
15 corporation organized under the laws of Delaware with its principal place of business at 600
16 North U.S. Highway 45, Libertyville, Illinois 60048.

17 5. Upon Information and belief, Motorola Trademark Holdings, LLC is a limited
18 liability corporation organized under the laws of Delaware with its principal place of business
19 at 600 North U.S. Highway 45, Libertyville, Illinois 60048.

20 JURISDICTION AND VENUE

21 6. This court possess subject matter jurisdiction under 15 U.S.C. § 1121 and 28
22 U.S.C. §§ 1331, 1332, 1338(a) and (b), and 1367.

23 7. Personal jurisdiction is proper in this district because Motorola has solicited and
24 conducted business within the State of California via its marketing and sales of infringing

1 devices and acts of dilution. Motorola Mobility LLC also maintains an office at 1000
2 Enterprise Way, Sunnyvale, CA 94089. Motorola Mobility LLC regularly conducts business
3 within the State of California. Motorola's products have been inserted into the stream of
4 commerce and directed towards California, amongst other places. Defendants' wrongful
5 actions have damaged Waves within the State of California.

6 8. Venue is proper in this district under 28 U.S.C. § 1391(b)(2), (c)(2), and(d)
7 because a substantial part of the acts giving rise to this cause of action occurred within this
8 judicial district, and Motorola's contacts are sufficient to subject it to personal jurisdiction in
9 this district.

10 **INTRADISTRICT ASSIGNMENT**

11 9. Per Civil L.R. 3-2(c), this intellectual property action shall be assigned on a
12 district-wide basis.

13 **BACKGROUND**

14 10. Waves is the world's leading developer and supplier of software-based audio
15 signal processing tools and hardware-based products. Waves itself has become synonymous
16 with top-of-the-line audio processing, and the company's products are used where superior
17 sound quality is a prerequisite, such as hit records, major motion pictures, and top-selling
18 games worldwide.

19 11. In consumer electronics applications, Waves provides various goods and
20 services that compensate for the acoustic quality limitations of small, power efficient speakers
21 systems found in today's most popular consumer products such as LCD TVs, notebook PCs,
22 portable speaker systems, mobile phones, and smart phones.

23 12. In addition to its own goods and services, Waves' technologies provide custom
24 semiconductor and digital signal processing solutions to some of the most important audio and

1 consumer electronics firms in the world including Altec Lansing, Audio Products International,
2 Clarion, JVC, Microsoft, Samsung, Sanyo, and Sony.

3 13. Waves owns the following trademarks registered in International Class 9 on the
4 Principal Register of the Federal Trademark Register of the United States: MAXX,
5 MAXXBASS, MAXXAUDIO, MAXXVOLUME ("Waves' Registered Marks").

6 14. Waves filed U.S. Trademark Application Serial No. 85/656,250 seeking to
7 register its MAXXVOICE mark ("Waves' Application Mark") in International Class 9 for
8 "software and hardware for voice enhancement in mobile phones, computers, smart phones and
9 VoIP."

10 15. In addition to the goodwill resulting from Waves' use of its registered marks,
11 Waves owns common law trademark rights and associated good will in its MAXX,
12 MAXXBASS, MAXXAUDIO, MAXXVOLUME, and MAXXVOICE marks based on
13 widespread use of those marks on consumer electronics and other sound-generating products
14 ("Waves' Common-Law Marks").

15 16. Waves' Registered Marks, Application Mark, and Common-Law Marks
16 (collectively, "Waves' Marks" or "the Waves Marks") are composed and used in such a way
17 that the public associates not only those marks, but the common characteristic "MAXX" of the
18 family, with Waves. Because Waves' Marks form a group of marks having a recognizable
19 common characteristic MAXX, they constitute a protectable family of marks ("Waves' MAXX
20 Family of Marks").

21 17. The "MAXX" trademark was registered on Mar. 21, 2006 under Reg. No.
22 3,070,047 and was first used in commerce at least as early as November 12, 1997. This mark
23 is incontestable, which, pursuant to Lanham Act, 15 U.S.C. § 1115, conclusively establishes
24 both Waves' exclusive right to use this mark in commerce and its validity. A copy of this

1 registration is attached hereto as Exhibit A.

2 18. The "MAXX" trademark has been registered for use with, among other things,
3 software for control, conditioning and modification of sound for use in audio applications and
4 technologies to improve sound quality and audio system design and computer and electronics
5 hardware.

6 19. The "MAXXAUDIO" trademark was registered on April 5, 2011 under Reg.
7 No. 3,941,010 and was first used in commerce at least as early as August 31, 2007. This mark
8 is incontestable, which, pursuant to Lanham Act, 15 U.S.C. § 1115, conclusively establishes
9 both Waves' exclusive right to use this mark in commerce and its validity. A copy of this
10 registration is attached hereto as Exhibit B.

11 20. The "MAXXAUDIO" mark has been registered for use with, amongst other
12 things, portable audio appliances including mp3 players.

13 21. The "MAXXBASS" trademark was registered on June 1, 2004 under Reg. No.
14 2,847,596 and was first used in commerce at least as early as April 17, 1998. The mark is
15 incontestable, which, pursuant to Lanham Act, 15 U.S.C. § 1115, conclusively establishes both
16 Waves' exclusive right to use this mark in commerce and its validity. A copy of this
17 registration is attached hereto as Exhibit C.

18 22. The "MAXXBASS" mark has been registered for use with, amongst other
19 things, portable audio appliances including mp3 players.

20 23. The "MAXXVOLUME" trademark was registered on Apr. 28, 2009 under Reg.
21 No. 3,612,855 and was first used in commerce at least as early as April 30, 2007. This mark is
22 incontestable, which, pursuant to Lanham Act, 15 U.S.C. § 1115, conclusively establishes both
23 Waves' exclusive right to use this mark in commerce and its validity. A copy of this
24 registration is attached hereto as Exhibit D.

1 24. The "MAXXVOLUME" mark has been registered for use with, amongst other
2 things, portable audio appliances including mp3 players.

3 25. Waves' Marks and MAXX Family of Marks are associated with the high quality
4 audio functionality provided by Waves.

5 26. Waves has won many awards for its products, including, but not limited to, a
6 prestigious 2011 Technical GRAMMY® Award for its innovative professional music
7 production software.

8 27. Millions of laptop computers and other sound producing consumer electronic
9 devices have been distributed across the United States (including in California) bearing one or
10 more of Waves' Marks.

11 28. Waves' mark MAXX and Waves' MAXX Family of Marks are famous in
12 California.

13 29. Motorola markets and has marketed mobile phone products under the names
14 "DROID RAZR MAXX" and "DROID RAZR MAXX HD."

15 30. The DROID RAZR MAXX and DROID RAZR MAXX HD have the capability
16 and are regularly used by consumers to produce sound from mp3 files.

17 31. The capability to play mp3 files as well as other audio formats is advertised by
18 Motorola as a feature of the DROID RAZR MAXX and DROID RAZR MAXX HD.

19 32. The DROID RAZR MAXX and DROID RAZR MAXX HD have become
20 associated with poor audio quality.

21 33. The poor quality of the sound reproduction in the DROID RAZR MAXX and
22 DROID RAZR MAXX HD mobile phones has tarnished and will continue to tarnish the value
23 of the Waves' Marks and Waves' reputation with respect to high quality audio reproduction.
24

1 34. Motorola's use of the terms "DROID RAZR" and "DROID RAZR MAXX" is
2 likely to give the false impression that a distinguishing feature between these products is
3 endorsement by Waves. The relevant public is likely to believe that the "DROID RAZR
4 MAXX" is endorsed by Waves while the "DROID RAZR" has no such endorsement.

5 35. Waves has no involvement with the audio or sound problems of the DROID
6 RAZR MAXX or DROID RAZR MAXX HD

7 36. Waves' MAXXAUDIO product is used by cellular telephone manufacturers
8 other than Motorola to improve the audio quality of their phones.

9 37. Motorola's use of the "MAXX" mark in connection with its products is likely to
10 impede Waves' ability to market its MAXX products to other cellular telephone manufactures.

11 38. Motorola's use of Waves' Marks in connection with inferior products will
12 discourage other mobile telephone manufacturers and sellers from adopting and advertising the
13 use of Waves' products as a feature of their mobile telephones and electronic products.

14 **MOTOROLA'S WILLFUL CONDUCT**

15 39. Waves informed Motorola of its trademark infringement of the Waves'
16 trademark MAXX on March 29, 2012.

17 40. Motorola became aware of the likelihood of confusion caused by its use of the
18 "MAXX" mark in relation to its products no later than March 29, 2012.

19 41. Despite being made aware of the likelihood of confusion, in a letter dated April
20 20, 2012 and signed by David C. Carroll, Motorola stated that it would continue to use the
21 "MAXX" mark in conjunction with its mobile phones and alleged that its use of the term
22 "MAXX" was merely descriptive.

23 42. After being informed of the likelihood of confusion and despite contending to
24 Waves that its use of the mark MAXX was merely descriptive, Motorola went on to file an
PLAINTIFFS' ORIGINAL COMPLAINT

1 application for registration of the mark "MAXX" on the Principal Trademark Register of the
2 United States. That application was signed by David C. Carroll and filed on December 3,
3 2012.

4 43. Motorola's trademark application for the mark "MAXX" was assigned serial
5 number 85/792,643. A copy of this application is attached hereto as Exhibit E.

6 44. Motorola filed its trademark application with full knowledge and in flagrant
7 disregard of Waves' trademark rights. Despite that knowledge, Motorola declared to the U.S.
8 Patent and Trademark Office that, to the best of its knowledge and belief, "no other person,
9 firm, corporation, or association has the right to use the mark in commerce, either in the
10 identical form thereof or in such near resemblance thereto as to be likely, when used on or in
11 connection with the goods/services of such other person, to cause confusion, or to cause
12 mistake, or to deceive." And despite claiming to Waves that its use of the term MAXX is
13 descriptive, the application filing demonstrates Motorola's belief that the mark is registrable to
14 Motorola on the principal register in International Class 9, the same class to which the Waves'
15 Marks are registered.

16 45. On January 7, 2013, Waves again notified Motorola by letter of its unlawful
17 conduct regarding Waves' trademark rights, including but not limited to, trademark
18 infringement.

19 46. On January 14, 2013, Motorola affirmed by response letter its intention to
20 continue to use the "MAXX" mark without regard to Waves' trademark rights while also
21 omitting to mention that following Waves' March 2012 notification Motorola applied to
22 register the mark "MAXX" for its own purposes.

23 **COUNT 1 – FEDERAL TRADEMARK INFRINGEMENT**

24 47. Plaintiffs incorporate by reference herein the allegations contained in
PLAINTIFFS' ORIGINAL COMPLAINT

1 paragraphs 1 through 46 of this Complaint.

2 48. Defendant's aforementioned acts constitute trademark infringement in violation
3 of section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1).

4 49. Waves' federal registrations on the Principal Register for the marks MAXX,
5 MAXXAUDIO, MAXXBASS, and MAXXVOLUME are incontestable pursuant to the
6 Lanham Act, 15 U.S.C. § 1115. Incontestability is conclusive evidence of their validity,
7 Waves' ownership of the marks and of Waves' exclusive right to use the marks in commerce in
8 connection with the goods and services specified in the certificates of registration under 15
9 U.S.C. § 1115(b).

10 50. Defendants are intentionally and wrongfully using in commerce unauthorized
11 reproductions, counterfeits, copies, and colorable imitations of Waves' Registered Marks in
12 connection with the sale, offering for sale, distribution, and advertising of Defendants' mobile
13 phone products, with full knowledge that such marks and designations are counterfeit marks.
14 Such uses are likely to cause confusion, or to cause mistake, or to deceive, including, without
15 limitation, by being likely to cause confusion as to sponsorship or authorization by Waves, or
16 alternatively, by destroying the origin-identifying function of MAXX and other of the Waves
17 Marks. Defendants' actions constitute trademark infringement in violation of section 32(1) of
18 the Lanham Act, 15 U.S.C. § 1114(1).

19 51. Defendants became aware of Waves' ownership of the Waves Marks including
20 MAXX no later than March 29, 2012.

21 52. Defendants have made extensive use of the mark MAXX in the promotion of
22 their products.

23 53. The foregoing acts of infringement have been and continue to be deliberate,
24 willful, and wanton, making this an exceptional case within the meaning of 15 U.S.C. § 1117.

1 54. Defendants' sales and marketing of the DROID RAZR MAXX and DROID
2 RAZR MAXX HD will likely continue unless enjoined by this Court.

3 55. As a proximate result of Motorola's actions, Waves has suffered and will
4 continue to suffer substantial damage to its business, goodwill, reputation, profits, and the
5 strength of its trademarks. The injury to Waves is ongoing and irreparable.

6 56. An award of monetary damages alone cannot fully compensate Waves for its
7 injuries, and Waves lacks an adequate remedy at law.

8 57. Waves is entitled to a permanent injunction against Defendants, as well as all
9 other remedies available under the Lanham Act, including, but not limited to, damages
10 sustained by the Plaintiffs, treble damages, disgorgement of Defendants' profits, and costs and
11 attorneys' fees.

12 **COUNT 2 – FEDERAL UNFAIR COMPETITION, FALSE DESIGNATION OF ORIGIN,**
13 **PASSING OFF AND FALSE ADVERTISING**

14 58. Plaintiffs incorporate by reference herein the allegations contained in
15 paragraphs 1 through 57 of this Complaint.

16 59. The Waves' Marks are used by Waves in connection with providing high
17 quality goods and services and are distinctive marks that have become associated with Waves
18 and thus exclusively identify Wave's business, products, and services.

19 60. Defendants are intentionally and wrongfully using unauthorized reproductions,
20 counterfeits, copies, and colorable imitations of Waves' Marks in commerce on and in
21 connection with Defendants' mobile phone products, resulting in false designations of origin,
22 false and misleading descriptions of fact, and false and misleading representations of fact that
23 are likely to cause confusion, to cause mistake, and to deceive as to the affiliation, connection,
24 or association of Defendants with Waves and as to the origin, sponsorship, or approval of

1 Defendants' mobile phone products and commercial activities by Waves, and that
2 misrepresents the nature, characteristics, and qualities Defendants' mobile phone products and
3 commercial activities, in violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).
4 For example, consumers are deceptively led to believe that the DROID RAZR MAXX and
5 DROID RAZR MAXX HD are sponsored by or otherwise approved by Waves, or
6 alternatively, that the Waves Marks are associated with poor audio functionality, thus
7 destroying the goodwill and value of Waves and the Waves Marks.

8 61. The foregoing acts and conduct by Defendants constitute false designation of
9 origin and false advertising in connection with products and services distributed in interstate
10 commerce, in violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

11 62. Defendants' acts, as set forth above, have caused irreparable injury to Waves'
12 goodwill and reputation. The injury to Waves is ongoing and irreparable.

13 63. Defendants' sales and marketing of the DROID RAZR MAXX and DROID
14 RAZR MAXX HD will likely continue unless enjoined by this Court.

15 64. Waves is entitled to a permanent injunction against Defendants, as well as all
16 other remedies available under the Lanham Act, including, but not limited to, compensatory
17 damages, treble damages, disgorgement of profits, and costs and attorney's fees.

18 65. An award of monetary damages alone cannot fully compensate Waves for its
19 injuries and Waves lacks an adequate remedy at law.

20 **COUNT 3 – INJUNCTION AGAINST USE OF FAMOUS MARK UNDER CAL.**
21 **BUS. & PROFESSIONS CODE § 14427**

22 66. Plaintiffs incorporate by reference herein the allegations contained in
23 paragraphs 1 through 65 of this Complaint.

1 67. The Waves Marks are famous and protectable marks in California and, on
2 information and belief, Plaintiffs' protected interest in those marks arose before Defendants'
3 use of those marks.

4 68. Waves has no control over the qualities, or lack thereof, of Defendants' DROID
5 RAZR MAXX and DROID RAZR MAXX HD products, its advertising and other promotional
6 materials related thereto, or is unauthorized use of the Waves Marks. As a result of such use by
7 Motorola, the business reputation of Waves as well as its MAXX Family of Marks is being
8 tarnished, and such tarnishing will continue unless stopped by this Court.

9 69. Defendants' sales and marketing of the DROID RAZR MAXX and DROID
10 RAZR MAXX HD and its use of and dissemination of materials bearing the Waves' Marks is
11 and will continue to result in the dilution of the distinctive nature of the Waves' Marks through
12 blurring.

13 70. Defendants' wrongful conduct constitutes an extreme threat to the
14 distinctiveness of the Waves Marks that Waves has expended great efforts to develop and
15 maintain through its strict control over the usage of the Waves Marks.

16 71. The Waves Marks are distinctive and of high value and they and the business
17 reputation of Waves with which they are associated has suffered and will continue to suffer
18 irreparable harm by such blurring and tarnishing if Defendants' wrongful conduct is allowed to
19 continue.

20 72. Defendants' acts, as set forth above, have caused irreparable injury to the
21 distinctive quality of Waves' Marks and the MAXX Family of Marks as well as Waves'
22 business reputation. This injury is ongoing and irreparable.

23 73. Defendants' sales and marketing of the DROID RAZR MAXX and DROID
24 RAZR MAXX HD will likely continue unless enjoined by this Court.

1 74. Waves is entitled to a permanent injunction against Defendants consistent with
2 California Business and Professions Code Section 14247.

3 **COUNT 4 – UNFAIR COMPETITION UNDER CAL. BUS. & PROFESSIONS**
4 **CODE § 17200 ET SEQ.**

5 75. Plaintiffs incorporate by reference herein the allegations contained in
6 paragraphs 1 through 74 of this Complaint.

7 76. Defendants have committed trademark infringement and other unlawful acts as
8 set forth above in violation of plaintiffs' proprietary rights in the Waves Marks. Such acts
9 constitute unfair trade practices and unfair competition under California Business and
10 Professions Code § 17200 et seq., and under the common law of the State of California,
11 entitling plaintiffs to relief.

12 77. Pursuant to California Business and Professions Code § 17203, Defendants' are
13 required to disgorge and restore to plaintiffs all profits and property acquired by means of
14 Defendants' unfair competition.

15 78. Due to the Defendants' conduct, Plaintiffs have suffered irreparable harm,
16 suffered injury in fact, and have lost money or property as a result of Defendants' acts of unfair
17 business practices alleged herein. It would be difficult to ascertain the amount of money
18 damages that would afford plaintiff adequate relief at law for Defendants' acts. Plaintiffs'
19 remedy at law is not adequate to compensate it for its injuries. Accordingly, Plaintiffs are
20 entitled to relief pursuant to California Business and Professions Code § 17203.

21 79. On information and belief, Defendants' conduct has been intentional and willful
22 and in conscious disregard of plaintiffs' rights and, therefore, Plaintiffs are entitled to their
23 attorneys' fees.

PRAYER FOR RELIEF

Plaintiffs respectfully request this Court to enter judgment in their favor against Defendant granting the following relief:

A. That Defendants and those persons and entities in concert or participation with Defendants, and their respective affiliates, successors, and assigns along with the directors, officers, agents, servants, and employees thereof be permanently enjoined from:

1. Using any of the Waves Marks in conjunction with the promotion, marketing, and advertising of any product with audio capabilities;
2. Diluting, tarnishing, blurring, and infringing the Waves' Marks and from injuring Waves' goodwill and reputation;
3. Passing off or falsely designating the origin of Defendants' products as those of Plaintiffs;
4. Doing any other act likely to induce the belief that Motorola products are in any way connected with, sponsored, affiliated, licensed, or endorsed by Waves.
5. Using any of the Waves Marks for goods or services, or on the internet or as domain names, email addresses, meta tags, invisible data or otherwise engaging in acts or conduct that would cause confusion as to the source, sponsorship or affiliation of Defendants with Waves.

B. That Defendants in accordance with 15 U.S.C. § 1116(a), be directed to file with this court and serve upon Waves within thirty days after service of the permanent injunction a report in writing under oath, setting forth in detail the manner and form in which Defendants have complied with the permanent injunction;

1 C. That Defendants be ordered to deliver an accounting to Plaintiffs within
2 thirty days of the entry of judgment;

3 D. That Defendants be ordered to deliver up for destruction all labels, signs,
4 prints, packages, wrappers, receptacles, and advertisements in their possession that bear
5 any of Waves' Marks or any reproduction, counterfeit, copy, or colorable imitation
6 thereof, and all plates, molds, matrices, and other means of making the same.

7 E. That Waves recovers its actual damages sustained as a result of
8 Defendants' wrongful actions or, if so elected by Plaintiffs, statutory damages under
9 15 U.S.C. § 1117(d);

10 F. That Defendants shall disgorge to Waves its profits made as a result of
11 Defendants' wrongful actions;

12 G. That Waves recover three times Defendants' profits made as a result of
13 Defendants' wrongful actions or three times Waves' damages, whichever is greater;

14 H. That this case be deemed an exceptional case under 15 U.S.C. §§ 1117(a)
15 and (b) and that Defendants be deemed liable for and ordered to reimburse Waves for its
16 reasonable attorneys' fees;

17 I. That Waves be awarded exemplary damages for Defendants' willful and
18 intentional acts;

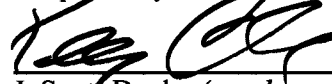
19 J. That Waves recover its costs of this action;

20 K. That Waves recover all prejudgment and postjudgment interest as allowed
21 by law; and

22 L. That Waves recover such further relief as may be just and proper.
23
24

Dated: 3/11/13

Respectfully Submitted,



J. Scott Denko (*pro hac vice pending*)
(Texas State Bar No. 00792457)
Bradley D. Coburn (*pro hac vice pending*)
(Texas State Bar No. 24036377)
R. Floyd Walker (*pro hac vice pending*)
(Texas State Bar No. 24044751)
Sherri A Wilson (*pro hac vice pending*)
(Texas State Bar No. 24075291)
DENKO COBURN LAUFF LLP
1501 S. MoPac Expy, Suite A315
Austin, TX 78746
Telephone: (512) 906-2074
Facsimile: (512) 906-2075
Email: denko@dclegal.com
coburn@dclegal.com
walker@dclegal.com

Perry R. Clark (California Bar No. 197101)
LAW OFFICES OF PERRY R. CLARK
825 San Antonio Road
Palo Alto, CA 94303
Telephone: (650) 248-5817
Facsimile: (650) 618-8533
Email: perry@perryclarklaw.com

ATTORNEYS FOR PLAINTIFFS

DEMAND FOR JURY TRIAL

Plaintiffs demand a jury trial for all issues triable by jury.

Dated: 3/11/13

Respectfully Submitted,


J. Scott Denko (*pro hac vice pending*)
(Texas State Bar No. 00792457)
Bradley D. Coburn (*pro hac vice pending*)
(Texas State Bar No. 24036377)
R. Floyd Walker (*pro hac vice pending*)
(Texas State Bar No. 24044751)
Sherri A. Wilson (*pro hac vice pending*)
(Texas State Bar No. 24075291)
DENKO COBURN LAUFF LLP
1501 S. MoPac Expy, Suite A315
Austin, TX 78746
Telephone: (512) 906-2074
Facsimile: (512) 906-2075
Email: denko@dclegal.com
coburn@dclegal.com
walker@dclegal.com

Perry R. Clark (California Bar No. 197101)
LAW OFFICES OF PERRY R. CLARK
825 San Antonio Road
Palo Alto, CA 94303
Telephone: (650) 248-5817
Facsimile: (650) 618-8533
Email: perry@perryclarklaw.com

ATTORNEYS FOR PLAINTIFFS

EXHIBIT A

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

United States Patent and Trademark Office

Reg. No. 3,070,047

Registered Mar. 21, 2006

**TRADEMARK
PRINCIPAL REGISTER**

MAXX

WAVES AUDIO LTD. (ISRAEL CORPORATION)
AZRIELI CENTER
1 ROUND BUILDING, 132 DE RECHPETACH-TIK-
VA
TEL AVIV, ISRAEL 67021

FOR: COMPUTER SOFTWARE FOR CONTROL,
CONDITIONING AND MODIFICATION OF ELEC-
TRONIC WAVEFORMS REPRESENTATIVE OF HU-
MAN-SENSIBLE SOUND FOR USE IN AUDIO
APPLICATIONS AND TECHNOLOGIES TO IM-

PROVE SOUND QUALITY AND AUDIO SYSTEM
DESIGN, AND COMPUTER AND ELECTRONICS
HARDWARE THEREFOR, IN CLASS 9 (U.S. CLS. 21,
23, 26, 36 AND 38).

FIRST USE 11-6-1997; IN COMMERCE 11-12-1997.

SER. NO. 78-199,177, FILED 12-31-2002.

BARBARA GAYNOR, EXAMINING ATTORNEY

EXHIBIT B

United States of America

United States Patent and Trademark Office

MAXXAUDIO

Reg. No. 3,941,010

Registered Apr. 5, 2011

Int. Cl.: 9

TRADEMARK

PRINCIPAL REGISTER

WAVES AUDIO LTD. (ISRAEL CORPORATION)
AZRIELI CENTER, TRIANGLE TOWER, 32ND FLR
132 DERECH PETACH-TIKVA
TEL AVIV, ISRAEL 67021

FOR: SOFTWARE AND ELECTRONIC EQUIPMENT FOR PROCESSING, TRANSMITTING, RECEIVING AND REPRODUCING AUDIO SIGNALS IN ORDER TO ENHANCE BASS QUALITIES, NAMELY, DIGITAL AUDIO WORK STATIONS CONSISTING OF COMPUTER HARDWARE AND SOFTWARE FOR REPRODUCING AUDIO SIGNALS IN ORDER TO ENHANCE BASS QUALITIES; DIGITAL AND ANALOG AUDIO MIXING CONSOLES; HOME AUDIO APPLIANCES, NAMELY, RADIOS, TELEVISION SETS, STEREO SYSTEMS AND MINI STEREO SYSTEMS CONSISTING OF AUDIO AMPLIFIERS, TUNERS, RECEIVERS, AND CD AND AUDIO TAPE PLAYERS; AND VIDEO CASSETTE PLAYERS; PORTABLE AUDIO APPLIANCES, NAMELY, RADIOS AND MP3 PLAYERS; MAGNETIC AND OPTICAL MEDIA CARRYING AUDIO SIGNALS THAT WERE SUBJECT TO BASS ENHANCEMENT, NAMELY, RECORDS, CD'S, AUDIO TAPES, AND MINI-DISKS FEATURING MUSICAL SOUND RECORDINGS; ELECTRONIC PROCESSORS FOR USE IN THE REPRODUCTION OF RECORDED SOUND OR STREAMING OF SOUND; SOUND RECORDINGS EMBODYING ENCODED INFORMATION FEATURING MUSICAL PERFORMANCES; KIT FOR THE SELF-LEARNING OF RECORDING, PROCESSING, RESTORING, MIXING AND MASTERING OF AUDIO CONTENT, SAID KIT COMPRISING PRE-RECORDED INSTRUCTIONAL CD'S AND DVD'S AND ASSOCIATED MANUALS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 8-31-2007; IN COMMERCE 8-31-2007.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,359,170, 2,847,596, AND 3,070,047.

SN 77-017,420, FILED 10-10-2006.

LESLIE RICHARDS, EXAMINING ATTORNEY



David J. Kyper

Director of the United States Patent and Trademark Office

EXHIBIT C

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

Reg. No. 2,847,596

United States Patent and Trademark Office

Registered June 1, 2004

**TRADEMARK
PRINCIPAL REGISTER**

MAXXBASS

**WAVES AUDIO LTD. (ISRAEL COMPANY)
23 KALISHER STREET
TEL-AVIV, ISRAEL 65165**

FOR: SOFTWARE AND ELECTRONIC EQUIPMENT FOR PROCESSING, TRANSMITTING, RECEIVING AND REPRODUCING AUDIO SIGNALS IN ORDER TO ENHANCE BASS QUALITIES, NAMELY, DIGITAL AUDIO WORK STATIONS CONSISTING OF COMPUTER HARDWARE AND SOFTWARE FOR REPRODUCING AUDIO SIGNALS IN ORDER TO ENHANCE BASS QUALITIES; DIGITAL AND ANALOG MIXING CONSOLES; DIGITAL AND ANALOG RACK-MOUNT PROCESSING EQUIPMENT, NAMELY, AUDIO SIGNAL PROCESSORS; AUDIO PROCESSING EQUIPMENT, NAMELY, COMPUTER HARDWARE FOR BROADCASTING AND GLOBAL COMPUTER NETWORK TRANSMISSION AND COMMUNICATIONS SOFTWARE USED TO ACCESS AND TRANSMIT AUDIO INFORMATION FROM WEBSITES ON A GLOBAL COMPUTER NETWORK; HOME AUDIO APPLIAN-

CES, NAMELY, RADIOS, TELEVISION SETS, CD PLAYERS, AUDIO CASSETTE PLAYERS, STEREO SYSTEMS, MINI STEREO SYSTEMS CONSISTING OF AUDIO AMPLIFIERS, TUNERS, RECEIVERS, CD AND AUDIO TAPE PLAYERS; AND VIDEO CASSETTE PLAYERS; PORTABLE AUDIO APPLIANCES, NAMELY, RADIOS, CD PLAYERS, MINI-DISK PLAYERS AND MP3 PLAYERS; MAGNETIC AND OPTICAL MEDIA CARRYING AUDIO SIGNALS THAT WERE SUBJECT TO BASS ENHANCEMENT, NAMELY, RECORDS, CD'S, AUDIO TAPES, MINI DISK FEATURING MUSICAL SOUND RECORDINGS; DOWNLOADABLE BASS ENHANCED MP3 AUDIO FILES FEATURING MUSICAL SOUND RECORDINGS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 9-0-1997; IN COMMERCE 9-0-1997.

SN 75-469,498, FILED 4-17-1998.

MARY BOAGNI, EXAMINING ATTORNEY

EXHIBIT D

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

United States Patent and Trademark Office

Reg. No. 3,612,855

Registered Apr. 28, 2009

**TRADEMARK
PRINCIPAL REGISTER**

MAXXVOLUME

WAVES AUDIO LTD. (ISRAEL CORPORATION)
AZRIELI CENTER, TRIANGLE TOWER, 32ND FLR
132 DERECH PETACH-TIKVA
TEL AVIV, ISRAEL 67021

FOR: SOFTWARE FOR PROCESSING, TRANSMITTING, RECEIVING AND REPRODUCING AUDIO SIGNALS IN ORDER TO ENHANCE BASS QUALITIES FOR A NUMBER OF APPLICATIONS, NAMELY, FOR MIXING AND MASTERING AUDIO SIGNALS FOR REPRODUCTION, BROADCASTING, POST-PRODUCTION, PODCASTING AND INTERNET STREAMING, FOR AUDIO PROCESSING AND LEVELING OF VOICEOVERS, VOCALS, AND INSTRUMENTAL TRACKS, AND FOR CONTROLLING THE DYNAMIC RANGE OF AUDIO SIGNALS; DIGITAL AND ANALOG AUDIO MIXING CONSOLES; DIGITAL AND ANALOG AUDIO RACK-MOUNT PROCESSING EQUIPMENT, NAMELY, AUDIO SIGNAL PROCESSORS; AUDIO PROCESSING EQUIPMENT, NAMELY, COMPU-

TER HARDWARE FOR BROADCASTING AND GLOBAL COMPUTER NETWORK TRANSMISSION AND COMMUNICATIONS SOFTWARE USED TO ACCESS AND TRANSMIT AUDIO INFORMATION FROM WEBSITES ON A GLOBAL COMPUTER NETWORK, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 4-30-2007; IN COMMERCE 4-30-2007.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,847,596 AND 3,070,047.

SN 77-017,443, FILED 10-10-2006.

STEVEN R. FOSTER, EXAMINING ATTORNEY

EXHIBIT E

PTO Form 1478 (Rev 9/2006)

OMB No. 0651-0009 (Exp 11/30/2008)

Trademark/Service Mark Application, Principal Register**Serial Number: 85792643****Filing Date: 12/03/2012****The table below presents the data as entered.**

| Input Field | Entered |
|--|--|
| SERIAL NUMBER | 85792643 |
| MARK INFORMATION | |
| *MARK | <u>MAXX</u> |
| STANDARD CHARACTERS | YES |
| USPTO-GENERATED IMAGE | YES |
| LITERAL ELEMENT | MAXX |
| MARK STATEMENT | The mark consists of standard characters, without claim to any particular font, style, size, or color. |
| REGISTER | Principal |
| APPLICANT INFORMATION | |
| *OWNER OF MARK | Motorola Trademark Holdings, LLC |
| *STREET | 600 N. U.S. Highway 45 |
| *CITY | Libertyville |
| *STATE (Required for U.S. applicants) | Illinois |
| *COUNTRY | United States |
| *ZIP/POSTAL CODE (Required for U.S. applicants only) | 60048 |
| EMAIL ADDRESS | mxg674@motorola.com |
| LEGAL ENTITY INFORMATION | |
| TYPE | limited liability company |
| STATE/COUNTRY WHERE LEGALLY ORGANIZED | Delaware |
| GOODS AND/OR SERVICES AND BASIS INFORMATION | |

| | |
|--|--|
| INTERNATIONAL CLASS | 009 |
| *IDENTIFICATION | Mobile phones, smartphones, and accessories therefor, namely, power adapters |
| FILING BASIS | SECTION 1(b) |
| ATTORNEY INFORMATION | |
| NAME | William R. Anderson |
| ATTORNEY DOCKET NUMBER | MTH1002375 |
| FIRM NAME | Motorola Trademark Holdings, LLC |
| STREET | 600 N. U.S. Highway 45 |
| CITY | Libertyville |
| STATE | Illinois |
| COUNTRY | United States |
| ZIP/POSTAL CODE | 60048 |
| EMAIL ADDRESS | mxg674@motorola.com |
| AUTHORIZED TO COMMUNICATE VIA EMAIL | Yes |
| OTHER APPOINTED ATTORNEY | David C. Carroll and all other attorneys of the firm |
| CORRESPONDENCE INFORMATION | |
| NAME | William R. Anderson |
| FIRM NAME | Motorola Trademark Holdings, LLC |
| STREET | 600 N. U.S. Highway 45 |
| CITY | Libertyville |
| STATE | Illinois |
| COUNTRY | United States |
| ZIP/POSTAL CODE | 60048 |
| EMAIL ADDRESS | mxg674@motorola.com |
| AUTHORIZED TO COMMUNICATE VIA EMAIL | Yes |
| FEE INFORMATION | |
| NUMBER OF CLASSES | 1 |
| FEE PER CLASS | 325 |
| *TOTAL FEE DUE | 325 |

| | |
|------------------------------|---------------------------|
| *TOTAL FEE PAID | 325 |
| SIGNATURE INFORMATION | |
| SIGNATURE | /dcc/ |
| SIGNATORY'S NAME | David C. Carroll |
| SIGNATORY'S POSITION | Director and Lead Counsel |
| DATE SIGNED | 12/03/2012 |

PTO Form 1478 (Rev 9/2006)
OMB No. 0651-0009 (Exp 11/30/2008)

Trademark/Service Mark Application, Principal Register

Serial Number: 85792643

Filing Date: 12/03/2012

To the Commissioner for Trademarks:

MARK: MAXX (Standard Characters, see mark)

The literal element of the mark consists of MAXX.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Motorola Trademark Holdings, LLC, a limited liability company legally organized under the laws of Delaware, having an address of

600 N. U.S. Highway 45
Libertyville, Illinois 60048
United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 009: Mobile phones, smartphones, and accessories therefor, namely, power adapters

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

The applicant's current Attorney Information:

William R. Anderson and David C. Carroll and all other attorneys of the firm of Motorola Trademark Holdings, LLC

600 N. U.S. Highway 45
Libertyville, Illinois 60048
United States

The attorney docket/reference number is MTH1002375.

The applicant's current Correspondence Information:

William R. Anderson
Motorola Trademark Holdings, LLC
600 N. U.S. Highway 45
Libertyville, Illinois 60048
mxg674@motorola.com (authorized)

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1

class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /dcc/ Date Signed: 12/03/2012
Signatory's Name: David C. Carroll
Signatory's Position: Director and Lead Counsel

RAM Sale Number: 11329
RAM Accounting Date: 12/03/2012

Serial Number: 85792643
Internet Transmission Date: Mon Dec 03 09:55:20 EST 2012
TEAS Stamp: USPTO/BAS-144.188.31.2-20121203095520890
263-85792643-4907115676f7965d5ad4e3de3fb
36a8f3-DA-11329-20121203093641691107

MAXX

CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON NEXT PAGE OF THIS FORM.)

I. (a) PLAINTIFFS

WAVES AUDIO LTD. AND WAVES INC.

DEFENDANTS

MOTOROLA MOBILITY LLC AND MOTOROLA TRADEMARK HOLDINGS, LLC

(b) County of Residence of First Listed Plaintiff N/A (Israel)
(EXCEPT IN U.S. PLAINTIFF CASES)

County of Residence of First Listed Defendant Lake County (IL.)
(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE TRACT OF LAND INVOLVED.

(c) Attorneys (Firm Name, Address, and Telephone Number)
See Attachment

Attorneys (If Known)

CV13-1091 EMC

II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- ☐ 1 U.S. Government Plaintiff
☐ 2 U.S. Government Defendant
☒ 3 Federal Question (U.S. Government Not a Party)
☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- | | PTF | DEF | | PTF | DEF |
|---|---------------------------------------|----------------------------|---|----------------------------|---------------------------------------|
| Citizen of This State | <input type="checkbox"/> 1 | <input type="checkbox"/> 1 | Incorporated or Principal Place of Business in This State | <input type="checkbox"/> 4 | <input type="checkbox"/> 4 |
| Citizen of Another State | <input type="checkbox"/> 2 | <input type="checkbox"/> 2 | Incorporated and Principal Place of Business in Another State | <input type="checkbox"/> 5 | <input checked="" type="checkbox"/> 5 |
| Citizen or Subject of a Foreign Country | <input checked="" type="checkbox"/> 3 | <input type="checkbox"/> 3 | Foreign Nation | <input type="checkbox"/> 6 | <input type="checkbox"/> 6 |

IV. NATURE OF SUIT (Place an "X" in One Box Only)

- | | | | | | |
|---|--|--|---|---|--|
| <input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excludes Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise | PERSONAL INJURY <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury <input type="checkbox"/> 362 Personal Injury - Medical Malpractice | PERSONAL INJURY <input type="checkbox"/> 365 Personal Injury - Product Liability <input type="checkbox"/> 367 Health Care/Pharmaceutical Personal Injury Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability PERSONAL PROPERTY <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability | <input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 690 Other | <input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 <input type="checkbox"/> 820 Copyrights <input type="checkbox"/> 830 Patent <input checked="" type="checkbox"/> 840 Trademark (9) | <input type="checkbox"/> 375 False Claims Act <input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 480 Consumer Credit <input type="checkbox"/> 490 Cable/Sat TV <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 890 Other Statutory Actions <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 896 Arbitration <input type="checkbox"/> 899 Administrative Procedure Act/Review or Appeal of Agency Decision <input type="checkbox"/> 950 Constitutionality of State Statutes |
| <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property | <input type="checkbox"/> 440 Other Civil Rights <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing/Accommodations <input type="checkbox"/> 445 Amer. w/Disabilities Employment <input type="checkbox"/> 446 Amer. w/Disabilities Other <input type="checkbox"/> 448 Education | Habeas Corpus: <input type="checkbox"/> 463 Alien Detainee <input type="checkbox"/> 510 Motions to Vacate Sentence <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty Other: <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition <input type="checkbox"/> 560 Civil Detainee - Conditions of Confinement | <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Management Relations <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 751 Family and Medical Leave Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Employee Retirement Income Security Act <input type="checkbox"/> 462 Naturalization Application <input type="checkbox"/> 465 Other Immigration Actions | <input type="checkbox"/> 861 HIA (1395ff) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g)) <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS—Third Party 26 USC 7609 | |

V. ORIGIN (Place an "X" in One Box Only)

- ☒ 1 Original Proceeding
☐ 2 Removed from State Court
☐ 3 Remanded from Appellate Court
☐ 4 Reinstated or Reopened
☐ 5 Transferred from Another District (specify)
☐ 6 Multidistrict Litigation

VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity):

15 U.S.C. 1114(1)

Brief description of cause:

Trademark

VII. REQUESTED IN COMPLAINT:

☐ CHECK IF THIS IS A CLASS ACTION UNDER RULE 23, F.R.Cv.P.

DEMAND \$

CHECK YES only if demanded in complaint:

JURY DEMAND: ☒ Yes ☐ No

VIII. RELATED CASE(S) IF ANY

(See instructions):

JUDGE

DOCKET NUMBER

IX. DIVISIONAL ASSIGNMENT (Civil L.R. 3-2)

(Place an "X" in One Box Only)

☐ SAN FRANCISCO/OAKLAND

☒ SAN JOSE

☐ EUREKA

DATE

SIGNATURE OF ATTORNEY OF RECORD

March 11, 2013

Authority For Civil Cover Sheet

The JS 44 civil cover sheet and the information contained herein neither replaces nor supplements the filings and service of pleading or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. Consequently, a civil cover sheet is submitted to the Clerk of Court for each civil complaint filed. The attorney filing a case should complete the form as follows:

- I. (a) **Plaintiffs-Defendants.** Enter names (last, first, middle initial) of plaintiff and defendant. If the plaintiff or defendant is a government agency, use only the full name or standard abbreviations. If the plaintiff or defendant is an official within a government agency, identify first the agency and then the official, giving both name and title.
- (b) **County of Residence.** For each civil case filed, except U.S. plaintiff cases, enter the name of the county where the first listed plaintiff resides at the time of filing. In U.S. plaintiff cases, enter the name of the county in which the first listed defendant resides at the time of filing. (NOTE: In land condemnation cases, the county of residence of the "defendant" is the location of the tract of land involved.)
- (c) **Attorneys.** Enter the firm name, address, telephone number, and attorney of record. If there are several attorneys, list them on an attachment, noting in this section "(see attachment)".
- II. **Jurisdiction.** The basis of jurisdiction is set forth under Rule 8(a), F.R.Cv.P., which requires that jurisdictions be shown in pleadings. Place an "X" in one of the boxes. If there is more than one basis of jurisdiction, precedence is given in the order shown below.
United States plaintiff. (1) Jurisdiction based on 28 U.S.C. 1345 and 1348. Suits by agencies and officers of the United States are included here.
United States defendant. (2) When the plaintiff is suing the United States, its officers or agencies, place an "X" in this box.
Federal question. (3) This refers to suits under 28 U.S.C. 1331, where jurisdiction arises under the Constitution of the United States, an amendment to the Constitution, an act of Congress or a treaty of the United States. In cases where the U.S. is a party, the U.S. plaintiff or defendant code takes precedence, and box 1 or 2 should be marked.
Diversity of citizenship. (4) This refers to suits under 28 U.S.C. 1332, where parties are citizens of different states. When Box 4 is checked, the citizenship of the different parties must be checked. (See Section III below; **NOTE: federal question actions take precedence over diversity cases.**)
- III. **Residence (citizenship) of Principal Parties.** This section of the JS 44 is to be completed if diversity of citizenship was indicated above. Mark this section for each principal party.
- IV. **Nature of Suit.** Place an "X" in the appropriate box. If the nature of suit cannot be determined, be sure the cause of action, in Section VI below, is sufficient to enable the deputy clerk or the statistical clerk(s) in the Administrative Office to determine the nature of suit. If the cause fits more than one nature of suit, select the most definitive.
- V. **Origin.** Place an "X" in one of the six boxes.
Original Proceedings. (1) Cases which originate in the United States district courts.
Removed from State Court. (2) Proceedings initiated in state courts may be removed to the district courts under Title 28 U.S.C., Section 1441. When the petition for removal is granted, check this box.
Remanded from Appellate Court. (3) Check this box for cases remanded to the district court for further action. Use the date of remand as the filing date.
Reinstated or Reopened. (4) Check this box for cases reinstated or reopened in the district court. Use the reopening date as the filing date.
Transferred from Another District. (5) For cases transferred under Title 28 U.S.C. Section 1404(a). Do not use this for within district transfers or multidistrict litigation transfers.
Multidistrict Litigation. (6) Check this box when a multidistrict case is transferred into the district under authority of Title 28 U.S.C. Section 1407. When this box is checked, do not check (5) above.
- VI. **Cause of Action.** Report the civil statute directly related to the cause of action and give a brief description of the cause. **Do not cite jurisdictional statutes unless diversity.** Example: U.S. Civil Statute: 47 USC 553 Brief Description: Unauthorized reception of cable service
- VII. **Requested in Complaint.** Class Action. Place an "X" in this box if you are filing a class action under Rule 23, F.R.Cv.P.
Demand. In this space enter the actual dollar amount being demanded or indicate other demand, such as a preliminary injunction.
Jury Demand. Check the appropriate box to indicate whether or not a jury is being demanded.
- VIII. **Related Cases.** This section of the JS 44 is used to reference related pending cases, if any. If there are related pending cases, insert the docket numbers and the corresponding judge names for such cases.

Date and Attorney Signature. Date and sign the civil cover sheet.

Attachment

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